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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,398	12/05/2003	William M. Brandt	14012-071001/70-03-007	8841
26230 7590 04/16/2007 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER LOVING, JARIC E	
			ART UNIT 2137	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/729,398	Applicant(s) BRANDT, WILLIAM M.	
	Examiner Jaric Loving	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/21/05, 10/17/05, 3/22/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 19-20 are objected to because of the following informalities: in line 1 of both claims, applicant recites "storage medium." It is suggested --computer readable storage medium-- is used. Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of § 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, a functional descriptive material *per se*.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kyle, US 6,853,739 in view of Black, US 6,539,101.

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In claims 1, 10, and 19, Kyle discloses a method, system and storage medium for preventing identity theft in electronic communications, comprising the steps of:

issuing to the individual a unique identifier from said trusted service (col. 5, lines 23-33; col. 6, lines 60-67); and

permitting the individual to generate and maintain a consumer-defined sequence through said trusted service (col. 7, lines 27-32 – identification code; col. 11, lines 46-56); and

allowing the individual to control access to commercially related use of said consumer identifier by third parties (col. 8, lines 20-27; col. 12, lines 37-46; col. 13, line 61 – col. 14, line 2).

Kyle fails to disclose sequencing an encryption key transaction from a trusted service for generating for an individual a consumer identifier by performing the steps of: issuing from said trusted service a primary key to the individual. Black discloses sequencing an encryption key transaction from a trusted service for generating for an individual a consumer identifier by performing the steps of (col. 10, lines 12-14; col. 11, lines 27-30; col. 12, lines 17-22 and lines 38-51): issuing from said trusted service a primary key to the individual (col. 12, lines 29-33 and lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Kyle's identity verification system with Black's identity verification method utilizing an encryption key to secure data during transmission. It is for this reason that one of ordinary skill in the art would have been motivated to provide Kyle's identity verification system with an encryption key because it provides consumers with

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privacy they may want while ensuring integrity of their accounts (Black, col. 4, lines 11-12).

In claims 2, 11, and 20, Kyle, as modified, discloses the method, system and storage medium of claims 1, 10, and 19, respectively, further comprising the steps of verifying commercially related use of said consumer identifier, comprising the steps of:

initiating a verification process from a requesting business entity via a secure connection (Kyle, col. 9, lines 49-62 – server initiates to communication control device; col. 11, lines 46-56);

comparing said consumer identifier with a pre-determined set of database records using said consumer-defined sequence in response to initiating said verification process (Kyle, col. 2, lines 37-46; col. 14, lines 4-23);

presenting a positive or negative confirmation to said requesting business, said business having registered with said trusted service (Kyle, col. 9, line 57 – col. 10, line 6; col. 11, line 58 – col. 12, line 22; col. 14, lines 4-23); and

confirming requested information relating to the individual via said secure connection, said requested information have been pre-authorized for presenting to said requesting business entity by the individual (Kyle, col. 9, line 57 – col. 10, line 6; col. 11, lines 46-56; col. 11, line 58 – col. 12, line 22; col. 14, lines 4-23).

In claims 3 and 12, Kyle, as modified, discloses the method and system of claims 2 and 11, respectively, further comprising the step of reporting to the individual the number of times at least one requesting business entity has initiated a verification

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process (Kyle, col. 9, lines 57-62 – feedback status would indicate number of requests; col. 14, lines 4-23).

In claims 4 and 13, Kyle, as modified, discloses the method and system of claims 2 and 11, respectively, further comprising the step of confirming requested information relating to the individual including the individual's name, address, and photograph (Kyle, col. 9, lines 25-31; Black, col. 5, lines 53-57).

In claims 5 and 14, Kyle, as modified, discloses the method and system of claims 2 and 11, respectively, further comprising the step of confirming requested information relating to the individual including the individual's fingerprints (Kyle, col. 6, lines 51-56).

In claims 6 and 15, Kyle, as modified, discloses the method and system of claims 1 and 10, respectively, further comprising the steps of storing said consumer identifier on a remote business database system and permitting the individual to modify said consumer identifier through a secure connection to a remote location (Kyle, col. 2, lines 37-46; col. 14, lines 4-23).

In claims 7 and 16, Kyle, as modified, discloses the method and system of claims 1 and 10, respectively, further comprising the step of issuing to the individual a unique identifier from said trusted service according to a pre-determined set of business rules associated with a remote business database system (Kyle, col. 5, lines 23-33; col. 6, lines 60-67).

In claims 8 and 17, Kyle, as modified, discloses the method and system of claims 1 and 10, respectively, further comprising the step of allowing the individual to control

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commercial transactions using said consumer identifier (Kyle, col. 8, lines 20-27; col. 12, lines 37-46; col. 13, line 61 – col. 14, line 2).

In claims 9 and 18, Kyle, as modified, discloses the method and system of claims 1 and 10, respectively, further comprising the step of issuing to the individual a unique identifier from said trusted service, said unique identifier conveying in encrypted information relating to the individual's age and locale (Kyle, col. 5, lines 23-33; col. 6, lines 60-67 – passport info contains age and locale; Black, col. 5, lines 53-57).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Stefik et al., US 7,043,453; Hawkins, US 6,119,233; Timson et al., US 6,041,412; LeBourgeois, US 6,026,166; Stambler, US 5,974,148; Houvener, US 5,657,389; Banker et al., US 2006/0112434; Duffy et al., US 2006/0075255; Freeman et al., US 2004/0162984; Hayward, US 2004/0025053; Hoffman, US 2006/0107069; Putta et al., US 2001/0032192; Peled et al., US 2005/0066165; Holdsworth, US 2005/0033702; Ricciardi et al., US 2004/0215981; Barkan et al., US 2003/0135731; Hardman et al., US 2004/0059941; Patton, US 2003/0051164; Gupta et al., US 2001/0037469.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaric Loving whose telephone number is (571) 272-1686. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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EMMANUEL MOISE
SUPERVISORY PATENT EXAMINER